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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,570	03/29/2001	Thomas C. Mesing	13DV14029	3495
29399	7590	03/22/2004	EXAMINER	
JOHN S. BEULICK C/O ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102-2740			COMPTON, ERIC B	
			ART UNIT	PAPER NUMBER
			3726	20

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/821,570

Applicant(s)

MESING ET AL.

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 13-15 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,781,205 to Cairns et al in view of WO 98/58986 to McDonald et al (T&N Technology Ltd).

Cairns et al disclose a method for manufacturing a bearing element comprising the steps of: forming a plurality of layers (see col. 3, lines 21-23), wherein the first layer is formed from a plurality of materials (a combination of two or more different materials fibers, see col 3. lines 26-29), and the second layer (a single layer of fiber, see col. 3, lines 21-22) is formed against the first layer and is formed from a single material, wherein the fibers include may carbon or graphite fibers, (see col. 2, lines 23-35), the layers may be braided or woven (see col. 3, lines 24-25);

forming a bearing element form the plurality of layers; and

impregnating the bearing element with a resin comprising fine particles of a solid lubricant (see col. 4, lines 30-35). The resin may be polyimide (see col. 4. lines 18-20). Furthermore, the fine particles may include PTFE (see col. 4, lines 41-44).

Cairns et al specifically, note "The low friction characteristics of such a structure are enhanced by utilizing particulate PTFE, with or without one or more particulate filler material, as solid lubricants." (col. 4, lines 58-61).

However, Cairns et al do not disclose plasma etching the bearing layers prior to bonding (i.e., impregnating step).

McDonald et al disclose a method of manufacturing a bearing element comprising: a layer of PTFE and a matrix material, including polyimide (see page 6, line 7). "Where adhesives are used, the bearing materials may require a pre-treatment such as chemical etching, **plasma pre-treatment**, irradiation, or the use of chemical coupling agents or adhesion promoters for example prior to the application of adhesive." Page 9, lines 13-17 (emphasis added).

Regarding claim 11, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Cairns et al by plasma-etching the bearing layers prior to bonding, in light of the teachings of McDonald et al, in order to improve bonding of the PTFE.

3. Claims 11, 13-15, 17, 19, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,095,170 to Stanley et al in view of US Patent 3,781,205 to Cairns et al and WO 98/58986 to McDonald et al (T&N Technology Ltd).

Stanley et al disclose a method for manufacturing a bearing element comprising the steps of: forming a plurality of layers (12,14), wherein the first layer (glass fibers with Teflon, 12) and a second layer (glass fibers, 14); forming a bearing element from the

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plurality of layers, wherein the layers are woven (see col. 1, lines 54-55); and impregnating the bearing element with a polyimide.

However, Stanley et al do not disclose that the polyimide resin comprises PTFE particles.

Cairns et al disclose the invention above, specifically forming a multi-layered composite bearing impregnated with a polyimide resin having PTFE particles. Cairns et al specifically, note "The low friction characteristics of such a structure are enhanced by utilizing particulate PTFE, with or without one or more particulate filler material, as solid lubricants." (col. 4, lines 58-61), the layers may be braided or woven (see col. 3, lines 24-25).

It would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al using a polyimide resin comprising PTFE particles, in light of the teachings of Cairns et al, in order to provide an enhanced bearing structure.

However, Stanley et al/Cairns et al do not disclose plasma etching the bearing layers prior to bonding (i.e., impregnating step).

McDonald et al disclose a method of manufacturing a bearing element comprising: a layer of PTFE and a matrix material, including polyimide (see page 6, line 7). "Where adhesives are used, the bearing materials may require a pre-treatment such as chemical etching, **plasma pre-treatment**, irradiation, or the use of chemical coupling agents or adhesion promoters for example prior to the application of adhesive." Page 9, lines 13-17 (emphasis added).

Regarding claim 11, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al/Cairns et al by plasma-etching the bearing layers prior to bonding, in light of the teachings of McDonald et al, in order to improve bonding of the PTFE.

Regarding claim 13, Stanley et al disclose that the first and thirds layers (12) comprises the first material (glass fibers with Teflon fibers), and the second layer (14) comprises the second material (glass fibers). Cairns et al disclose two or more materials may be used.

Regarding claim 14, Stanley et al disclose that the layers are woven fabric (col 1, lines 120-125). Cairns et al disclose that the layers are may be braided or woven (col. 3, lines 24-25).

Regarding claim 15, Stanley et al disclose that weaves are known in the art (col 2, lines 75-84) and that various interweaving can be utilized for various strength characteristics. Therefore, a skill artisan would have found it obvious to use a braided layer, since braids are a well-known weave design. Cairns et al disclose that the layers are may be braided or woven (col. 3, lines 24-25).

Regarding claim 17, Stanley et al disclose that layers may impregnated or bonded together with an epoxy.

Regarding claim 19, quartz is essentially naturally occurring glass fiber. Therefore, a skilled artisan would have found it obvious to use either, since it has been held to be within the general skill of a worker in the art to select a known material on the

basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 20, Official Notice is taken that silane is a well-known coupling agent. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a silane coupling agent, in light of the Official Notice taken, in order to secure the bearing to a support.

4. Claims 11, 13-15, 17, 19, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,095,170 to Stanley et al in view of US Patent 4,111,499 to McCloskey and WO 98/58986 to McDonald et al (T&N Technology Ltd).

Stanley et al disclose a method for manufacturing a bearing element comprising the steps of: forming a plurality of layers (12,14), wherein the first layer (glass fibers with Teflon, 12) and a second layer (glass fibers, 14); forming a bearing element from the plurality of layers, the layers may be woven (see col. 1, lines 54-55); and impregnating the bearing element with a polyimide.

However, Stanley et al do not disclose that the polyimide resin comprises PTFE particles.

McCloskey discloses a method for manufacturing a bearing comprising fibers (4) impregnated with polyimide resin matrix having a random dispersion of polytetrafluoroethylene (Teflon) particles (see Figure 3). McCloskey discloses that the bearing material "includes a dry self-lubricating material for providing a low sliding friction surface, and which is wear resistant under heavy and constant loads and in further capable if operating in a hostile environment ..." (col 1, lines 45-50).

It would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al using a polyimide resin comprising PTFE particles, in light of the teachings of McCloskey, in order to provide a better friction surface in hostile environments.

McCloskey discloses chemical etching prior to impregnating the layers in order to improve the bonding quality. See Col. 5, lines 28-46. However, Stanley et al/McCloskey do not disclose plasma etching the bearing layers prior to bonding (i.e., impregnating step).

McDonald et al disclose a method of manufacturing a bearing element comprising: a layer of PTFE and a matrix material, including polyimide (see page 6, line 7). "Where adhesives are used, the bearing materials may require a pre-treatment such as chemical etching, **plasma pre-treatment**, irradiation, or the use of chemical coupling agents or adhesion promoters for example prior to the application of adhesive." Page 9, lines 13-17 (emphasis added).

Regarding claim 11, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al/McCloskey et al by plasma-etching the bearing layers prior to bonding, in light of the teachings of McDonald et al, in order to improve bonding of the PTFE.

Regarding claim 13, Stanley et al disclose that the first and thirds layers (12) comprises the first material (glass fibers with Teflon fibers), and the second layer (14) comprises the second material (glass fibers).

Regarding claim 14, Stanley et al disclose that the layers are woven fabric (col 1, lines 120-125).

Regarding claim 15, Stanley et al disclose that weaves are known in the art (col 2, lines 75-84) and that various interweaving can be utilized for various strength characteristics. Therefore, a skill artisan would have found it obvious to use a braided layer, since braids are a well-known weave design.

Regarding claim 17, Stanley et al disclose that layers may impregnated or bonded together with an epoxy.

Regarding claim 19, quartz is essentially naturally occurring glass fiber. Therefore, a skilled artisan would have found it obvious to use either, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 20, Official Notice is taken that silane is a well known coupling agent. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a silane coupling agent, in light of the Official Notice taken, in order to secure the bearing to a support.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanley et al/Cairns et al/McDonald et al as applied to claim 17 above, and further in view of US Patent 3,873,168 to Viola et al.

Stanley et al/Cairns et al/McDonald et al disclose the invention cited above. However, they do not disclose the substituting carbon fibers for glass fibers.

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Viola discloses a bearing formed almost identical to that of the Stanley et al comprising: forming a plurality of layers (12,14) from a combination of a first material (graphite fibers, 12) and a second material (glass fibers, 14); forming a bearing element from the plurality of layers, the layers may be woven (see col. 2, lines 55-65); and impregnating the bearing element with a polyimide resin.

Regarding claim 18, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al/Cairns et al/McDonald et al using carbon fibers, in light of the teachings of Viola et al, in order to provide a more wear resistant bearing (col. 3, line 40).

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanley et al/McCloskey/McDonald et al as applied to claim 17 above, and further in view of US Patent 3,873,168 to Viola et al.

Stanley et al/McCloskey/McDonald et al disclose the invention cited above. However, they do not disclose the substituting carbon fibers for glass fibers.

Viola discloses a bearing formed almost identical to that of the Stanley et al comprising: forming a plurality of layers (12,14) from a combination of a first material (graphite fibers, 12) and a second material (glass fibers, 14); forming a bearing element from the plurality of layers, the layers may be woven (see col. 2, lines 55-65); and impregnating the bearing element with a polyimide resin.

Regarding claim 18, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et

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al/McCloskey/McDonald et al using carbon fibers, in light of the teachings of Viola et al, in order to provide a more wear resistant bearing (col. 3, line 40).

Response to Arguments

7. Applicant's arguments filed January 26, 2004, have been fully considered but they are not persuasive.

Applicant's primary contention is that the Examiner has not establish a *prima facie* case for obviousness because there is no teachings or suggestion supporting the proposed combination the prior art, esp. Cairns et al. ("Cairns") and McDonald et al. ("McDonald"). Response, Page 3 (arguing hindsight rejection).

MPEP § 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regards to the first criterion, in setting forth the above obviousness rejection based on Cairns in view of McDonald , the Examiner stated,

Regarding claim 11, it would have been obvious for one of ordinary skill in the art at the time of invention, to have formed the bearing of Stanley et al/McCloskey et al by plasma-etching the bearing layers prior to bonding, in light of the teachings of McDonald et al, in order to improve bonding of the PTFE.

Non-Final Office Action dated December 10, 2003, page 3. Cairns discloses "The adhesive which may be used to secure the bearing surface layer (or low friction lamina) to the backing member (or supporting lamina) to provide the composite bearing in accordance with the invention may be any of the well known high temperature adhesives or bonding resins which do not unduly decompose at the temperature at which the bearing surface is to be used, and which have the capacity to assure a good, high strength bond between the fibrous low friction layer and the particular backing material employed." Col. 4, lines 9-18. As noted above, McDonald discloses "Where adhesives are used, the bearing materials may require a pre-treatment such as chemical etching, plasma pre-treatment, irradiation, or the use of chemical coupling agents or adhesion promoters for example prior to the application of adhesive." Page 9, lines 13-17. The Examiner has proffered a suggestion and/or motivation to combine the reference teachings based on the prior art. Furthermore in formulating the motivation to combine the references, the Examiner in no way relied on the teachings of Appellant's own disclosure. Thus, the first criterion is satisfied.

With regards to the second criterion, the Examiner previously pointed out that plasma etching promotes adhesion, as clearly taught by McDonald. Applicant has not put forth any evidence that the method of either Cairns or McDonald is unreliable or unsuccessful. In determining the expectation of success, the Examiner in no way relied on the teachings of Appellant's own disclosure. Therefore, the second criterion is satisfied.

With regards to the third criterion, the Examiner previously established that the references, as combined, teach all the claim limitations. See Non-Final Office Action, pages 2-3. However, Applicant argues that neither Cairns nor McDonald teach or suggest “impregnating each of the bearing elements plurality of layers with a polyimide resin” or “plasma etching each of the bearing elements layers.” Response, Page 5.

Contrary to Applicant’s contention, Cairns clearly suggests that each of the bearing elements is impregnated with resin. “If desired, the yarns or threads can be preimpregnated with a suitable resin impregnant adhesive to facilitate bonding with the backing member...” Col. 3, lines 43-46. “[W]here the bearing surface is formed of a cloth woven of fibers of one of the preferred materials, the backing member may comprise additional layers of such cloth that have been impregnated with a reinforcing resin which is subsequently cured to provide the desired rigidity.” Col. 5, lines 17-22; See *a/so* Claim 1 (reciting the lamina is impregnated with a resin bonding material). McDonald teaches “attaching the bearing material layer to a strong backing layer by adhesive means ...” Page, 7, lines 27-28. Like Cairns, McDonald teaches “It is possible to deposit the layer in several stages, i.e. one layer on top of another to produce a thicker deposited layer.” Page 9, lines 19-21. Since Cairns teaches impregnating each of layers with adhesive, one having ordinary skill in the art at the time of invention, would have found it obvious to have plasma etched each layer, as taught by McDonald in order to promote adhesion. Therefore, the third criterion is satisfied.

Having satisfied all three criteria, the Examiner maintains a *prima facie* case of obviousness has been properly established.

Applicant further tries to distinguish the references by arguing Cairns is formed such "the low friction bearing surfaces ... can be bonded through the means of an adhesive to a suitable backing metal backing," and that McDonald teaches forming "a bearing element that includes a slurry layer and an element which may require plasma-treating to facilitate bonding." Response, Page 4. The slurry of McDonald is essentially the same as the bearing surface layers of Cairns, both having various fibers and low friction material dispersed therethrough. See McDonald, Page 3, lines 4-23; Cairns, Col. 20-29. Applicant's characterization of Cairns' use of a metal backing is not entirely correct. In fact, Cairns discloses "Other filaments, fabrics and suitable resin impregnants for providing the backing member will readily occur to those skilled in the art." Col. 3, lines 55-57. McDonald also teaches providing the back later with polymers to promote adhesion. Page 10, lines 17-20.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has made a *prima facie* showing that providing PTFE particles to polyimide resin to form a bearing element is suggested in the art to provide a better friction surface in hostile environments. Furthermore, the Examiner made a *prima facie* showing that plasma

etching the bearing layers prior to bonding (i.e., impregnating step) to improve bonding adhesion of the PTFE.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, the fact that McDonald may disclose another type of bearing structure does not detract from its teachings, that plasma discharge improves adhesive bonding.

Applicant's arguments with respect to Stanley and McCloskey are believed to be redundant to the arguments made with respect to Cairns and McDonald, and essentially have been properly addressed above.

In conclusion, the rejections are maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

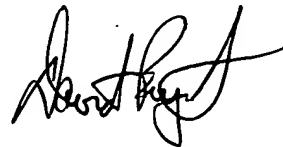
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Compton
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AU 3726



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